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10/612,659	07/02/2003	Delma S. Hume	02-337	5530
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Caterpillar Inc. Intellectual Property Dept. AH 9510 100 N.E. Adams Street PEORIA, IL 61629-9510				
EXAMINER				
FRENEL, VANEL				
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3687				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/612,659

**Applicant(s)**

HUME ET AL.

**Examiner**

VANEL FRENEL

**Art Unit**

3687

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/17/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-19 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-19 and 24-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the Amendment filed on 12/17/08. Claims 15-19 have been amended. Claims 2-23 have been cancelled. Claims 24-33 have been newly added. Claims 15-19 and 24-33 are pending.

### **Claim Rejections - 35 USC § 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-19 and 24-33 are rejected under 35 U.S. C.103 (a) as being unpatentable over Junger (6,463,421) in view of Hauser et al. (6,536,659).

As per claims 15, 24 and 29, Junger discloses a method for remanufacturing cores into remanufactured items, comprising the steps of: "providing a total price for the remanufactured items, the total price including at least a refundable core deposit and a

remanufactured item price, the core deposit being paid with the total price to secure return of cores for remanufacture (See Junger, Co1.3, lines 33-65 to Co1.4, line 14); storing, in a memory device, data reflecting an earlier core liability and a later core liability, the earlier core liability corresponding to a core deposit paid upon sale of earlier-sold one of the remanufactured items, the later core liability corresponding to a core deposit paid upon sale of a later-sold one of the remanufactured items (See Junger, Co1.3, lines 33-65 to Co1.4, line 14); receiving a core associated with the sale of the later-sold remanufactured item (See Col.8, lines 53-65); inspecting the core associated with the sale of the later-sold remanufactured item core (See Junger, Col.7, lines 26-67).

Junger does not explicitly disclose determining an amount of credit available for returning the core associated with the sale of the later-sold remanufactured item, the amount being based upon the inspection; and which to updating the data stored on the memory device by applying the credit for the core associated with the sale of the later-sold remanufactured item against the earlier core liability, irrespective of the core deposit for the later-sold remanufactured item having been paid after the sale of the earlier-sold remanufactured item paid on sale of the item associated with the return.

However, these features are known in the art, as evidenced by Hauser. In particular, Hauser suggests that the method having determining an amount of credit available for returning the core associated with the sale of the later-sold remanufactured item, the amount being based upon the inspection (See Hauser, Col.2, lines 39- 67); and which to updating the data stored on the memory device by applying the credit for

the core associated with the sale of the later-sold remanufactured item against the earlier core liability, irrespective of the core deposit for the later-sold remanufactured item having been paid after the sale of the earlier-sold remanufactured item paid on sale of the item associated with the return (See Hauser, Col.5, lines 58-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Hauser within the system of Junger with the motivation of providing a method which defined for handling returned merchandise on behalf of a plurality of different merchants (See Hauser, Col.2, lines 10-12).

As per claim 16, Junger discloses the method wherein the step of determining the amount of core credit is from a choice of one of full credit equal to the core deposit paid upon sale of the later-sold remanufactured item, partial credit less than the core deposit paid upon sale of the later-sold remanufactured item, and zero credit (See Junger, Col.9, lines 1-7).

As per claim 17, Junger discloses the method further including the steps of: establishing an earlier entitlement corresponding to the earlier core liability having an amount equal to the core deposit paid with the total price of the earlier-sold core to secure return of core and a date identifier (See Junger, Col.8, lines 33-67); and canceling the earlier entitlement after return of the core associated with the later- sold remanufactured item where the entitlement is the oldest available entitlement identifier (See Junger, Col.8, lines 33-67).

As per claim 18, Junger discloses the method further comprising: establishing a core liability and a corresponding attrition date for a sale of a selected one of the remanufactured items, the attrition date being after a date on which the selected remanufactured item is sold (See Junger, Co1.3, lines 33-65 to Co1.4, line 14); and eliminating the core liability for the selected remanufactured item on the attrition date when a core has not been returned for the selected remanufactured item by the attrition date wherein the step of selecting the oldest available liability includes (See Junger, Col.8, lines 33-60).

As per claim 19, Junger discloses the method further comprising: establishing a partial credit date associated with the sale of the selected remanufactured item, the partial credit date being after the date on which the selected remanufactured item is sold and before the attrition date (See Junger, Col.8, lines 33-60); and limiting the core liability for the selected remanufactured item to a value less than the corresponding core deposit if the core is returned on or after the partial credit date and before the attrition date wherein the step of applying the credit against the selected liability includes applying full credit against the selected liability where the core was received within a first time period ending prior to the attrition date and applying less than full credit where the core was received within a second time period of the attrition (See Junger, Col.8, lines 33-65).

Claims 25-28 and 30-33 recite the underlying process steps of the elements of claims 16-19, respectively. As the various elements of claims 16-19 and have been shown to be either disclosed by or obvious in view of the collective teachings of Junger and Hauser, it is apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 25-28 and 30-33 are rejected for the same reasons given above for method claims 16-19, and incorporated herein.

***Response to Arguments***

4. Applicant's arguments filed 12/17/08 with respect claims 15-19 and 24-34 have been fully considered but they are not persuasive.

(A) At pages 10-15 of the response filed on 12/17/08, Applicant's argues the followings:

(i) The rejection of claims 15-19 under 35 U.S.C. 101 should be withdrawn.

(ii) A prima facie case of obviousness has not been established with respect to the claims.

(iii) Junger does not teach or suggest a method for remanufacturing cores into remanufactured items, comprising the steps of: "providing a total price for the remanufactured items, the total price including at least a refundable core deposit and a

remanufactured item price, the core deposit being paid with the total price to secure return of cores for remanufacture.

(iv) Hauser does not disclose any core deposit that paid as part of a total purchase price for such goods.

(v) Hauser fails to teach or suggest updating the data stored on the memory device by applying the credit for the core associated with the sale of the later-sold remanufactured item against the earlier core liability, irrespective of the core deposit for the later-sold remanufactured item.

(B) With respect to Applicant's first argument, the Examiner respectfully submitted that Applicant argument has been persuasive with respect to the 101 rejection. Therefore, the 101 rejection is hereby withdrawn.

(C) With respect to Applicant's second argument, the Examiner respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has



presented evidence of corresponding claim elements in the prior art by expressly pointing to specific portions of each applied reference and has expressly articulated the combinations and the motivations for combinations as well as the scientific and logical reasoning of one skilled in the art at the time of the invention that fairly suggest Applicant's claimed invention. Each applied reference does not expressly suggest combination with the other respective references; however, the Examiner has shown that motivation for combining the references existed in the prior art. Within the present combinations, all of the modifications proposed by the Examiner are taught by the references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection maintained. In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, In re Bozek, 163 USPQ 545 (CCPA 1969). The Examiner is concerned that Appellant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in

In re DeLisle 406 Fed 1326, 160 USPQ 806; In re Kell, Terry and Davies 208 USPQ 871; and In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in In re Lamberti et al, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

(D) With respect to Applicant's third, fourth and fifth arguments, the Examiner respectfully submitted that He relied upon the teaching of Hauser (See Fig.5, Col.8, lines 23-67) which correspond to Applicant's argument. As such, the Examiner respectfully submitted that such terms were given their broadest reasonable interpretations during examinations, and since the applied reference clearly discloses the claimed limitations, when given their broadest reasonable interpretations, it is respectfully submitted that the Examiner reliance on Hauser is indeed proper.

### **Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nanel Frenel/

Examiner, Art Unit 3687

March 23, 2009